

In re Appln. of CHAWLA et al.
Application No. 10/008,489

REMARKS

Summary of Office Action

The November 21, 2003, Office Action consists of a two-way restriction requirement, as follows: Group I (an adhesive composition, claims 1-19, 32-37, 45, and 48); Group II (optical media, claims 20-31, 38-44, 46, 47 and 49). The Action states that Applicant's arguments submitted in a response to a prior restriction requirement regarding Groups II and III have been considered but are moot in view of the new restriction requirement.

The Action advises that the inventions of Group I and II are distinct from one another because they represent mutually exclusive species in an intermediate-final product relationship. Because the inventions are distinct, and have acquired a separate status in the art (as shown by their different classifications), the Action concludes that restriction is proper.

In addition, the Office Action consists of an election of species requirement. The Office contends that compounds 1-12 are distinct species, and a single disclosed species needs to be elected for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Discussion of Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*" *M.P.E.P.* § 803, emphasis added.

Applicants respectfully traverse the restriction requirement. Although the inventions of Groups I and II may be patentably distinct, Applicants submit that a single search would provide all prior art relevant to each group due to the overlapping nature of the subject matter claimed therein. For example, a search for the optical media of Group II would also include a search for the adhesive of Group I because the latter is included in the former, albeit in an uncured form. Withdrawal of the restriction requirement on this basis is respectfully solicited.

If the restriction requirement is made final, however, Applicants provisionally elect the claims of Group I (1-19, 32-37, 45, and 48) for prosecution at this time.

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Discussion of Election of Species

Applicants respectfully traverse the election of species requirement. The election of species requirement is improper because the species, compounds 1-12, have sufficient common structural aspects to warrant their consideration as a group. For example, compounds 1-12 all are heterocyclic compounds with at least one double bond. As set forth in the Manual of Patent Examining Procedure (M.P.E.P.) § 803.02, unity of invention exists if all species recited in a claim (1) show a common utility (e.g., radiation-curable composition with enhanced curing characteristics), and (2) a substantial structural feature essential to that utility (e.g., a heterocyclic compound). Therefore, the pending claims demonstrate unity of invention relative to the specific compounds recited in the pending claims.

If the examiner still considers an election requirement to be proper, Applicants propose that compounds 1-12 should be divided into two species groups, in accordance with their common structural aspects: Group I (compounds 1-7) and Group II (compounds 8-12). Group I compounds are heterocyclic with at least two double bonds, one N atom with either another N atom or an S or O atom in the ring structure, and a thiol substituent wherein a double bond is adjacent to the thiol. The claims that are readable upon the Group I species are claims 1-11, 13, 15, 16, 20-28, and 30-43. The Group II compounds are heterocyclic with at least one double bond, at least two N atoms, and no thiol substituent. The claims that are readable upon the Group II species are 1-4, 11-16, 20-28, and 30-43.

Finally, if the examiner continues to believe an election is required, Applicants propose that compounds 1-12 be further divided into three groups, in accordance with their common structural aspects: Group I (compounds 1, 2, and 6), Group II (compounds 3, 4, 5, and 7), and Group III (compounds 8-12). The Group I compounds are bicyclic with four double bonds, at least one N atom with either another N atom or an S or O atom in the ring structure, and a thiol substituent wherein a double bond is adjacent to the thiol. The claims that are readable upon the Group I species are 1-7, 11, 12, 15, 16, 20-28, and 30-43. Group II compounds are heterocyclic with at least two double bonds, at least two N atoms, and a thiol substituent wherein a double bond is adjacent to the thiol. The claims that are readable upon the Group II species are 1-4, 8-10, 13, 15, 16, 20-28, and 30-43. Group III compounds are heterocyclic with at least one double bond, at least two N atoms, and no thiol substituent. The claims that are readable upon the Group III species are 1-4, 11-16, 20-28, and 30-43.

If the election of species requirement set forth in the Action is made final, however, Applicants provisionally elect compound 1 for prosecution at this time. The claims that are readable upon compound 1 are 1-6, 11, 15, 16, 20-28, 30-34, and 37-43. If the Office decides

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to group compounds 1-12 into either Groups I and II or Groups I, II, and III, as proposed by Applicants, Applicants provisionally elect the species within Group I.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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